

REMARKS

In the Office Action mailed from the United States Patent and Trademark Office on November 28, 2006, the Examiner rejected claims 21-29, 32-38, and 40-43 under 35 U.S.C. 103(a) as being unpatentable over Evans (United States Patent No. 5,924,074, hereinafter “Evans”), Feldon et al. (United States Patent No. 5,732,221, hereinafter “Feldon”), Lavin et al. (United States Patent No. 5,772,585, hereinafter “Lavin”), Provost et al. (United States Patent No. 6,341,265, hereinafter “Provost”) and Lancelot et al (United States Patent No. 6,434,531, hereinafter “Lancelot”). Applicant respectfully submits that the claim set provided herein is not made obvious by the cited references, and respectfully provides the following:

The standard for a Section 103 rejection is set for in M.P.E.P 706.02(j), which provides:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis added).

Applicant respectfully submits that the references cited by the Examiner do not teach or suggest all of the limitations claimed in the present invention. In particular, independent claim 21 recites a method for generating, displaying and recording healthcare service information, the method comprising: electronically selecting a pool of healthcare procedures characteristically performed by a particular healthcare provider of a healthcare facility for inclusion in a customizable form, wherein the pool of healthcare procedures reflect the medical services rendered by the particular healthcare provider; electronically selecting one or more healthcare diagnoses characteristically employed by the particular healthcare provider for inclusion in the

customizable form, wherein the one or more diagnoses are reasons for performing at least one of the procedures from the pool of healthcare procedures characteristically performed by the particular healthcare provider; generating the customizable form by defining display specifications that relate to a display of the healthcare procedures characteristically performed by the particular healthcare provider and the healthcare diagnoses characteristically employed by the particular healthcare provider, wherein the display specifications are based on individual user preferences, and wherein said step for generating the customizable form comprises: using a computer interface to define a new structure for the customizable form that is not generated from a printed data form, selecting a number of rows for inclusion into the customizable form, defining specifications relating to the pool of healthcare procedures, defining specifications relating to the one or more healthcare diagnoses, displaying a reference to the customizable form in a searchable field within a form definition window, populating one or more fields of the form definition window, displaying the form definition window with the populated fields, entering procedure and diagnosis codes, and displaying a preview of the customizable form; and determining a particular sequence of the pool of healthcare procedures based upon user preferences; selecting at least one of (i) a diagnosis of the customizable form and (ii) a procedure of the customizable form in association with the healthcare provider rendering one of the procedures from the pool of healthcare procedures on a patient; and displaying billing information on a real time basis and prior to the rendering of the one of the procedures on the patient to allow the healthcare provider to advise the patient as to healthcare service to be rendered, including the most cost efficient healthcare alternative for the patient.

Independent claim 33 recites a computer program product for implementing within a computer system a method for generating, displaying and recording healthcare information, the

computer program product comprising: a computer readable medium for providing computer program code means utilized to implement the method, wherein the computer program code means is comprised of executable code for implementing the steps for: receiving a selection of a pool of healthcare procedures characteristically performed by a particular healthcare provider of a healthcare facility for inclusion in a customizable form, wherein the pool of healthcare procedures reflect the medical services rendered by the particular healthcare provider; receiving a selection of one or more healthcare diagnoses characteristically employed by the particular healthcare provider for inclusion in the customizable form, wherein the one or more diagnoses are reasons for performing at least one of the procedures from the pool of healthcare procedures characteristically performed by the particular healthcare provider; generating the customizable form by defining display specifications that relate to a display of the healthcare procedures characteristically performed by the particular healthcare provider and the healthcare diagnoses characteristically employed by the particular healthcare provider, wherein the display specifications are based on individual user preferences, and wherein said step for generating the customizable form comprises: using a computer interface to define a new structure for the customizable form that is not generated from a printed data form, selecting a number of rows for inclusion into the customizable form, defining specifications relating to the pool of healthcare procedures, defining specifications relating to the one or more healthcare diagnoses, displaying a reference to the customizable form in a searchable field within a form definition window, populating one or more fields of the form definition window, displaying the form definition window with the populated fields, entering procedure and diagnosis codes, and displaying a preview of the customizable form; and determining a particular sequence of the pool of healthcare procedures based upon user preferences; and rendering the customizable form for use

in association with the healthcare provider performing one of the procedures from the pool of healthcare procedures on a patient, wherein the step for rendering the customizable form for use comprises: (i) indicating a selection of a diagnosis of the customizable form, (ii) indicating a selection of a procedure of the customizable form, and (iii) indicating any cost modification for the diagnosis or the procedure indicated on the customizable form different from a cost typically billed by the particular healthcare provider for the diagnosis or the procedure indicated on the customizable form, and wherein the step for rendering the customizable form further includes displaying billing information on a real time basis and prior to the performing of the one of the procedures on the patient to allow the healthcare provider to advise the patient as to healthcare service to be provided, including the most cost efficient healthcare alternative for the patient.

Independent claim 42 recites a method for generating, displaying and recording healthcare service information, the method comprising: electronically selecting a pool of healthcare procedures characteristically performed by a particular healthcare provider of a healthcare facility for inclusion in a customizable form, wherein the pool of healthcare procedures reflect the medical services rendered by the particular healthcare provider; electronically selecting one or more healthcare diagnoses characteristically employed by the particular healthcare provider for inclusion in the customizable form, wherein the one or more diagnoses are reasons for performing at least one of the procedures from the pool of healthcare procedures characteristically performed by the particular healthcare provider; generating the customizable form by defining display specifications that relate to a display of the healthcare procedures characteristically performed by the particular healthcare provider and the healthcare diagnoses characteristically employed by the particular healthcare provider, wherein the display specifications are based on individual user preferences, and wherein said step for generating the

customizable form comprises: using a computer interface to define a new structure for the customizable form that is not generated from a printed data form, selecting a number of rows for inclusion into the customizable form, defining specifications relating to the pool of healthcare procedures, defining specifications relating to the one or more healthcare diagnoses, displaying a reference to the customizable form in a searchable field within a form definition window, populating one or more fields of the form definition window, displaying the form definition window with the populated fields, entering procedure and diagnosis codes, and displaying a preview of the customizable form; and determining a particular sequence of the pool of healthcare procedures based upon user preferences; and selecting at least one of (i) a diagnosis of the customizable form and (ii) a procedure of the customizable form in association with the healthcare provider rendering one of the procedures from the pool of healthcare procedures on a patient.

In each of independent claims 21, 33 and 42, the step for generating the customizable form comprises: using a computer interface to define a new structure for the customizable form that is not generated from a printed data form, selecting a number of rows for inclusion into the customizable form, defining specifications relating to the pool of healthcare procedures, defining specifications relating to the one or more healthcare diagnoses, displaying a reference to the customizable form in a searchable field within a form definition window, populating one or more fields of the form definition window, displaying the form definition window with the populated fields, entering procedure and diagnosis codes, and displaying a preview of the customizable form. These limitations are supported by the disclosure as originally filed. For example, reference is made to Figures 3A – 3B, and the corresponding discussion. And, none of the references cited by the Examiner, alone or in combination, teaches or suggests such limitations.

As provided in the Office Action, the Examiner has indicated:

Evans, Feldon, Lavin and Provost fails to expressly disclose:

using a computer interface to define a new structure for the customizable form that is not generated from a printed data form, selecting a number of rows for inclusion into the customizable form, defining specifications relating to the pool of healthcare procedures and to the one or more healthcare diagnoses, and displaying the customizable form in a definition window. (See Office Action, pages 6-7)

Applicant respectfully submits that Lancelot fails to disclose a step for generating a customizable form comprising: using a computer interface to define a new structure for the customizable form that is not generated from a printed data form, selecting a number of rows for inclusion into the customizable form, defining specifications relating to the pool of healthcare procedures, defining specifications relating to the one or more healthcare diagnoses, displaying a reference to the customizable form in a searchable field within a form definition window, populating one or more fields of the form definition window, displaying the form definition window with the populated fields, entering procedure and diagnosis codes, and displaying a preview of the customizable form.

Accordingly, Applicant respectfully submits that for at least the reasons provided herein, the references cited by the Examiner, alone or in combination, do not teach or suggest all the limitations of independent claims 21, 33 or 42. And, since the references cited by the Examiner do not teach or suggest each and every limitation of independent claims 21, 33 or 42, Applicant respectfully submits that the prior art references do not make obvious independent claims 21, 33 or 42, as provided herein.

And since the prior art references do not make obvious independent claims 21, 33 or 42, Applicant respectfully submits that the prior art references cited by the Examiner do not make obvious the corresponding dependent claims, which depend from independent claims 21, 33 or 42.

Thus, Applicant respectfully submits that for at least the reasons provided herein, the claim set as provided herein overcomes all rejections made by the Examiner in the Office Action.

CONCLUSION

Applicant submits that the amendments made herein do not add new matter and that the claims are now in condition for allowance. Accordingly, Applicant requests favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

DATED this 29th day of May, 2007.

Respectfully submitted,

DAVID B. TINGEY
Attorney for Applicant
Registration No. 52,289

KIRTON & McCONKIE
1800 Eagle Gate Tower
60 East South Temple
Salt Lake City, Utah 84111
Telephone: (801) 321-4814
Facsimile: (801) 321-4893

DBT:cdl
::ODMA\PCDOCS\DOCS\975368\1